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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,163	12/06/2000	Dan Candura	40655.0200	9154

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EXAMINER

ROBINSON BOYCE, AKIBA K

ART UNIT	PAPER NUMBER
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3639

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/731,163

Applicant(s)

CANDURA ET AL.

Examiner

Akiba K Robinson-Boyce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/10/05 has been entered.

Status of Claims

2. This communication is in response to communications filed 9/3/04. This is a non-final office action. Claims 1-14 and 18 are pending in this application and have been examined on the merits. Claims 1-14 and 18 are rejected as follows.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-14 and 18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to a non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful art” (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claim 1 is directed to a method for evaluating the performance of a financial advisor. Claim 1 recites the steps of “reading a case prepared by the financial advisor, wherein said case provides recommendations”, “assigning a numerical value for said case in each of said plurality of areas based on said rating”, “compiling at least one result using said numerical values”, and “providing said at least one result to the financial advisor”. These steps represent mere ideas in the abstract since no computer means or software embodied on a tangible medium exist for processing the steps of the claim. Since no computer means or software embodied on a tangible medium exist for processing the steps of the claim, claim 1, and all claims that depend from it, (claims 2-12 and 18) are therefore found to be non-statutory.

In the present case, claim 13 is directed to a method for evaluating the performance of a financial advisor. Claim 13 recites the steps of “selecting a case prepared by the financial advisor, wherein said case provides recommendations”,

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"selecting a first assessor and a second assessor", "said first assessor rating said case in a plurality of areas by comparing said case to a predetermined standard", "assigning a first numerical value for said case in each of said plurality of areas based on said rating by said first assessor", "said second assessor assigning a second numerical value for said case in each of said plurality of areas based on said rating by said second assessor", "comparing said first numerical value to said second numerical value in one of said plurality of areas", "compiling at least one result using at least one of said first numerical value and said second numerical value", and "providing said at least one result to the financial advisor". These steps represent mere ideas in the abstract since no computer means or software embodied on a tangible medium exist for processing the steps of the claim. Since no computer means or software embodied on a tangible medium exist for processing the steps of the claim, claim 13, and all claims that depend from it, (claim 14) is therefore found to be non-statutory.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-14, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Havens (US 5,909,669) as cited by applicant, and further in view of Tom (US 5,696,907), as cited by applicant.

As per claim 1, Havens discloses:

reading a case...wherein said case provides recommendations, (col. 2, lines 3-7, using the knowledge worker productivity assessments to suggest modifications to the information environment)

rating said case in a plurality of areas by comparing said case to a predetermined standard, (Col. 3, lines 41-45, [qualitatively assessing information criteria],w/ Col. 1, lines 14-19, [assessing by comparing to a benchmark value]); and

assigning a numerical value for said case in each of said plurality of areas based on said rating, (col. 3, lines 46-49, [assigning a numeric value]).

compiling at least one result using said numerical values, (col. 3, lines 49-53, the qualitative content of the assessments);

providing said at least one result..., (col. 3, lines 52-57, generating a qualitative assessment to the individual performing the assessment).

Havens fails to disclose the evaluation of the performance of a financial advisor, but does disclose the assessment and evaluation of a knowledge worker in Col. 2, lines 32-34.

However, Tom discloses a financial advisor in col. 2, lines 21-22 and lines 53-55, where the credit manager represents the financial advisor and since the credit manager is shown to evaluate financial service applications for approval, and the financial service

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applications is further evaluated by the system. Tom discloses this limitation in an analogous art for the purpose of showing that credit managers are involved in the processing of financial applications.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to evaluate the performance of a financial advisor with the motivation of analyzing and determining assessment values for workers in the financial industry.

As per claim 2, Havens discloses:

repeating said reading, rating, and assigning steps for a plurality of cases for the financial advisor being evaluated, (col. 2, lines 33-35, [shows a plurality of information criteria which represents a plurality of cases, Col. 4, lines 41-57, [conducting one or more surveys]]).

As per claim 3, Havens discloses:

wherein said repeating step is performed by a different person than said reading, comparing, and rating steps, (Col. 1, lines 23-27, [shows that managers/consultants perform the assessment process, Col. 3, lines 41-49, [shows that workers perform the reading, comparing and rating steps by qualitatively assessing information criterion]]).

As per claim 4, Havens discloses:

wherein said financial advisor is a member of a larger group of financial advisors, each group comprising a plurality of financial advisors, further comprising:

compiling data regarding the ratings of the group, (Col. 4, lines 30-40, [surveyed as a whole]).

As per claim 5, Havens discloses:

The method of claim wherein a higher numerical value indicates increased compliance with said predetermined standard, (Col. 3, line 62-col. 4, line 6, [where a rating of "10" means information must consistently be adequate for assigned tasks and a "1" means that they need not ever be relevant.

As per claims 6, Havens fails to disclose Financial Planning/Financial Position, Protection Planning; Disability; Life Insurance; Long-Term Care; Investment Planning; Tax Planning; Retirement Planning; Estate Planning; Communication; Overall rating, but does disclose a rating procedure for a knowledge worker through assessment in the abstract, lines 1-4.

However, Tom discloses:

Wherein said plurality of areas comprises:

Financial Planning/Financial Position, (col. 2, lines 53-55, analyzing {by another entity} the credit manager's previously approved analysis of financial service applications).

Tom does not specifically disclose the following, however, the following is obvious with Tom since Tom does disclose Financial Planning through the credit analysis of financial service applications and the following are all part of financial planning: Protection Planning; Disability; Life Insurance; Long-Term Care; Investment Planning; Tax Planning; Retirement Planning; Estate Planning; Communication; Overall rating.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to include Protection Planning; Disability; Life Insurance; Long-Term Care; Investment Planning; Tax Planning; Retirement Planning; Estate Planning; Communication; and Overall rating with the motivation of including various parts of the financial planning process into deriving an appropriate financial plan.

As per claim 7, Havens fails to disclose wherein said plurality of areas comprises at least one of the following: Cash reserves; Budget/Expenses/Cash Flow/Debt Management; Overall financial Position rating; Disability Insurance...but does disclose a rating procedure for a knowledge worker through assessment in the abstract, lines 1-4.

However, Tom discloses:

Overall Financial Position...(col. 2, lines 53-55, analyzing {by another entity} the credit manager's previously approved analysis of financial service applications where financial service includes all of the above limitations, also Col. 4, lines 34-39, credit history, debts and income). Tom discloses this limitation in an analogous art for the purpose of showing that financial service applications can be used in the assessment process.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to include the Overall Financial Position with the motivation of evaluating the performance of financial data.

As per claim 8, Havens discloses:

wherein said reading, rating, and assigning steps are completed by a plurality of assessors, (col. 2, lines 35-40, shows that all references to a worker include knowledge workers, w/ col. 3, lines 42-57, shows workers (individual performing the assessment) assess the productivity of other workers).

As per claim 9, Havens fails to disclose wherein said reading, rating, and assigning steps are completed by a plurality of financial advisors, but does disclose a rating procedure for a knowledge worker through assessment in the abstract, lines 1-4.

However, Tom discloses:

wherein said reading, rating, and assigning steps are completed by a plurality of financial advisors, (col.2, lines 21-22, w/ lines 47-55, [credit managers who evaluate financial service applications]). Tom discloses this limitation to show that the credit managers are the ones that actually do the evaluating {of the financial applications}).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention for the reading, rating and assigning steps to be completed by a plurality of financial advisors with the motivation of showing that the evaluation is done by a network of advisors.

As per claim 10, Havens discloses:

wherein said reading, rating, and assigning steps are completed for each case in a subset of all cases produced by the financial advisor during a predetermined time period, (Col. 1, lines 27-29, [accessing for a selected time period]).

As per claim 11, Havens discloses:

The method of claim wherein said numerical value comprises a numerical rating that is an integer selected from the group consisting of 1, 2, 3, 4, and 5, and wherein: a numerical rating of 1 in a particular area indicates that the recommendation in that area is considered questionable; a numerical rating of 2 in a particular area indicates that the recommendation in that area is considered limited, a numerical rating of 3 in a particular area indicates that the recommendation in that area is reasonably informative with respect to any actions that are recommended; a numerical rating of 4 in a particular area indicates that the recommendation in that area details the reasons for the recommendation of a particular action and the manner in which an action should be performed; and a numerical rating of 5 in a particular area indicates that the recommendation in that area sufficiently provides an analysis of alternative courses of actions in addition to detailing the reasons for the recommendation of a particular action, (col. 3, lines 57-Col. 4, line 6, [where this scale represents the numerical rating since this scale represents ratings for the assessment of information criteria and definitions of what ratings stand for, only on a wider level]).

As per claim 12, Havens fails to disclose providing negative feedback to said financial advisor if said numerical rating in any of said plurality of areas is at least one of 1 and 2, but does disclose a rating procedure for a knowledge worker through assessment in the abstract, lines 1-4.

However, Tom discloses:

providing negative feedback to said financial advisor if said numerical rating in any of said plurality of areas is at least one of 1 and 2, (Col. 6, lines 54=-57, [negative

influence representation before a contract is approved]). Tom discloses this limitation in an analogous art for the purpose of showing that before a contract is approved, some type of negative influence will be acknowledged.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to provide negative feedback with the motivation of providing the evaluator with information about the status of the performance.

As per claim 13, Havens discloses:

selecting a case prepared by the financial advisor, wherein said case provides recommendations, (Col. 3, lines 42-46, [the generated survey]);

selecting a first assessor and a second assessor, (col. 2, lines 7-10, shows that assessments may be limited to selected knowledge workers or groups of knowledge workers, 45-53, also col. 4, lines 41-56, shows one or more assessment done at the same time. Havens does not specifically disclose the selection of a first and a second assessor, however this feature is inherent with the cited passage since a first and second assessor must be selected in order for one or more surveys (includes two surveys) to be assessed at the same time and that groups of knowledge workers are selected);

said first assessor rating said case in a plurality of areas by comparing said case to a predetermined standard, (Col. 3, lines 41-45, [qualitatively assessing information criteria], w/ Col. 1, lines 14-19, [assessing by comparing to a benchmark value], again, Havens does not disclose the selection of a first assessor for a specific part of the assessment, however, this feature is inherent with Havens since it is shown that

knowledge worker assessments may be scalable to include knowledge workers from similar knowledge worker environments as shown in col. 2, lines 10-13);

assigning a first numerical value for said case in each of said plurality of areas based on said rating by said first assessor, (Col. 11, lines 28-30, [one or more surveys generates rank segments]);

said second assessor assigning a second numerical value for said case in each of said plurality of areas based on said rating by said second assessor, (col. 13, lines 3-4, [segmenting ranks into segments], w/ Col. 13, lines 18-20, [calculating comparison values from segments], again, Havens does not disclose the selection of a second assessor for a specific part of the assessment, however, this feature is inherent with Havens since it is shown that knowledge worker assessments may be scalable to include knowledge workers from similar knowledge worker environments as shown in col. 2, lines 10-13), and

comparing said first numerical value to said second numerical value in one of said plurality of areas, (Col. 13, lines 37-40, [comparing comparison values for one or more surveys]).

compiling at least one result using said numerical values, (col. 3, lines 49-53, the qualitative content of the assessments);

providing said at least one result to the financial advisor, (col. 3, lines 52-57, generating a qualitative assessment to the individual performing the assessment).

Havens fails to disclose the evaluation of the performance of a financial advisor, but does disclose the assessment and evaluation of a knowledge worker in Col. 2, lines 32-34.

However, Tom discloses a financial advisor in col. 2, lines 21-22 and lines 53-55, where the credit manager represents the financial advisor and since the credit manager is shown to evaluate financial service applications for approval, and the financial service applications is further evaluated by the system. Tom discloses this limitation in an analogous art for the purpose of showing that credit managers are involved in the processing of financial applications.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to evaluate the performance of a financial advisor with the motivation of analyzing and determining assessment values for workers in the financial industry.

As per claim 14, Havens discloses:

selecting an arbitrator, (Col. 15, lines 18-19, [inherent with retrieving survey data since an arbitrator is the one who needs to retrieve the selected survey data in order to make an assessment]);

said arbitrator rating said case in a plurality of areas by comparing said case to a predetermined standard, (Col. 15, lines 20-26, [generating comparison value]).

assigning a third numerical value for said case in each of said plurality of areas based on said rating by said arbitrator, (col. 4, line 65-Col. 5, line 1, [ordinal variables]).

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Havens fails to disclose finalizing said rating based on said third numerical value, but does disclose the assessment and evaluation of a knowledge worker in Col. 2, lines 32-34.

However, Tom discloses finalizing said rating based on said third numerical value, (col. 5, lines 41-44, [final decision]). Tom discloses this limitation in an analogous art for the purpose of showing that a final decision with respect to the evaluation of a credit manager's assessment of a financial service application.

As per claim 18, Havens fails to disclose wherein said plurality of areas comprises at least one of: Cash reserves; Cash Flow; Overall Financial Position rating; Overall rating of Disability Insurance section; Overall rating of Life Insurance section; Overall rating of Long-term Care section; Overall rating of Investment Planning section; Overall rating of Tax Planning section; Overall rating of Retirement Planning section; Overall rating of Estate Planning section; Linkage; Organization and presentation; and Overall rating of the work-product, but does disclose a rating procedure for a knowledge worker through assessment in the abstract, lines 1-4.

However, Tom discloses:

Overall Financial Position rating...(col. 2, lines 53-55, analyzing {by another entity} the credit manager's previously approved analysis of financial service applications where financial service includes all of the above limitations, also Col. 4, lines 34-39, credit history, debts and income). Tom discloses this limitation in an analogous art for the purpose of showing that financial service applications can be used in the assessment process.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to include the Overall Financial Position with the motivation of evaluating the performance of financial data.

Response to Arguments

5. Applicant's arguments filed 1/24/05 have been fully considered but they are not persuasive.

The applicants disagree with the 35 U.S.C. 101 rejection given in the previous office action to claims 1-14 and 18. However, these claims do not recite computer hardware or software embodied on a tangible medium to help process the steps of the claims. Since these claims do not recite these type of means, the examiner can interpret that the steps of the claims are being performed by a person just simply using a pen and a piece of paper, thereby making the claims not statutory. The claims do produce a useful, concrete and tangible result, however, since the claims do not recite computer hardware or software embodied on a tangible medium to help process the steps of the claims, the 35 USC 101 rejection is therefore proper.

The applicant argues that the combination of Havens (US 5,909,669) and Tom (US 5,696,907) do not disclose the limitations of claims 1-14 and 18, specifically because, according to applicant, prior art does not suggest "reading a case prepared by a financial advisor". However, it is the combination of Havens and Tom that discloses a financial advisor. Specifically, in col. 2, lines 21-22 and lines 53-55 of Tom, the credit manager represents the financial advisor. In this case, the credit manager is shown to evaluate financial service applications for approval, and the financial service

applications are further evaluated by the system. Here, the financial service applications being further evaluated by the system represent the applications prepared by the credit manager being read.

The applicant also argues that neither reference teaches or suggests the step of "reading a case prepared by the financial advisor, wherein said case provides recommendations". However, Havens discloses this limitation. Specifically in col. 2, lines 3-7, Havens discloses that the knowledge worker productivity assessments are used to suggest modifications to the information environment surrounding the surveyed knowledge workers. It is the combination of Havens and Tom that discloses the financial advisor. Specifically, in col. 2, lines 21-22 and lines 53-55, the credit manager disclosed represents the financial advisor since the credit manager is shown to evaluate financial service applications for approval, and the financial service applications is further evaluated by the system. The applicant further argues that a financial advisor is one who provides financial advice to a client. However, Tom also discloses that guidelines for approving financial service applications can be written and issued to credit managers. In this case, the credit manager will use the guidelines to approve a client's financial service application, which will in turn, advise a client that it is ok to go with a particular financial service.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba K Robinson-Boyce whose telephone number is

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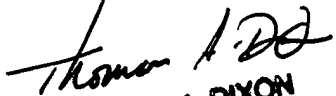
571-272-6734. The examiner can normally be reached on Monday-Tuesday 8:30am-5pm, and Wednesday, 8:30 am-12:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7238 [After final communications, labeled "Box AF"], 703-746-7239 [Official Communications], and 703-746-7150 [Informal/Draft Communications, labeled "PROPOSED" or "DRAFT"].

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

QNB

A. R. B.
May 24, 2005


THOMAS A. DIXON
PRIMARY EXAMINER